

REMARKS

The present amendment addresses all of the issues raised by the examiner in the office action on the merits of December 14, 2004 and amends the relevant pending claims in the manner discussed in the interview of December 14, 2004. Claims 1-8, 33, 35-36, 133-139, 159, 161 and 180, 184-186 remain in the application. No new matter has been added and the pending claims are believed to be in condition for allowance.

The applicant expressly reserves the right to pursue the previously cancelled and unclaimed subject matter as well as adopting possible further allowed claims such as for the purposes of an interference with then co-pending allowed application 10/730,586 (or successors thereto) in a continuing and/or divisional application(s).

The examiners comments will be addressed in turn.

ALLOWED CLAIMS

The examiner is thanked for the indication that claims 1-6 and 133-136 are currently allowable. These claims remain in the application.

INTERVIEW

The examiner is thanked for the courtesies extended in the interview on January 12, 2005. The claims have been amended largely as discussed in the interview. Minor additional editorial additions have been added for claim clarity.

RESTRICTION REQUIREMENT

The examiner required a restriction of claims 181-183. These have been cancelled, subject to the applicant's right to pursue these claims in a duly filed divisional application prior to the issuance or abandonment of this application (or the last pending continuation thereof).

SPECIFICATION

The examiner is thanked for withdrawing the prior drawing objection in response to the earlier submission. The examiner objected to the previously claimed description that the indicia on the counting wheel was indicative of character attributes since, as the applicant's counting wheel (also called a measurement wheel) is rotated the wheel indicia constantly changes. The claims have been amended to be in conformance with the specification. The examiner is correct that the game pieces have defines character indicia, such as character piece alignment, attack value, defense value, movement value

and range value. These values are modified during the play of the game, as part of playing the game. Namely, the character at the beginning of a turn can move a maximum of its movement value as listed on the character. The counting wheel is used, during piece movement, to modify this value and identify how much is left in the move. In other words, a character can move a total of 10 units in a turn, and the counting wheel will count the movement up till that point in the turn so the player can keep track of how much more is left in that turn. The character still has a maximum value of 10 for a per turn movement, but the wheel is modifying this amount so the player knows that he only has, for example, 3 space left if the wheel has counted out 7 spaces. In this sense the wheel indicia is modifying the associated character indicia. This is important where the game is being used to help learn to judge distances and no pre-measuring is permitted, whereby the players are making judgments of whether the character can reach a desired location, and re-evaluating those decisions as needed during the movement (the non-linear movement allows an abrupt change of course if the player decides on a new location (e.g. he believes he can no longer make it to the desired location in this turn and wants to alter to a more preferable intermediate location). The range measurements are similar, wherein the counter wheel gives a modification to the range value during the measurement (e.g. at a given point in the projectile path the wheel identifies that the arrow has a maximum of 3 units left to travel at this point in its path). However, with range the feedback or modification of the characters range attribute becomes less critical unless the rules included "smart" munitions, whereby the player could change the desired projectile course or target in flight. Again, with movement, this feedback/ modification of the associated character attribute of movement is an important aspect of the game, since it is anticipated that the players can and will alter the selected course of conduct based upon the modified character attributes or feedback from the wheel.

PRIORITY/DRAWINGS

The examiner has noted that the parent application did not include the description that the movement measurement device may be a wheel or a sphere. This disclosure can be found in the Grandparent application 09/479,531 and the Provisional Patent Application that were properly incorporated by reference in the parent application. The examiner again objects to the previously claimed language that the measuring or counter

wheel indicia are indicative of a character attribute, suggesting that this is not supported in the specification. As discussed in the interview, the language has been clarified to indicate that the measuring or counter wheel indicia are used to modify the associated indicia as noted above. This clarification should avoid the new matter/priority issue. There is no new matter in this application and it is a proper continuation of the parent application. Further the claim amendments clarifying this relationship should avoid the need for additional drawings in this case.

35 U.S.C. 112 REJECTIONS

The examiner has rejected the claims under 35 U.S.C. 112 first paragraph due to an alleged lacking of essential material. The examiner has again objected to the previously claimed language that the measuring or counter wheel indicia are indicative of a character attribute, suggesting that this is not supported in the specification. As discussed in the interview, the claim language has now been clarified to indicate that the measuring or counter wheel indicia are used to modify the associated indicia as noted above. This relationship between the wheel indicia and the character indicia is believed to be an important aspect of the present invention. These amendments and clarification are believed to address the issues raised by the examiner.

PRIOR ART REJECTIONS

WEISMAN PATENT APPLICATION

The examiner attempts to reject certain claims in view of the additional teachings of U.S. Published Patent Application 2002010150 to Weisman. It is presumed that the examiner has made this rejection based upon the above question to priority. The Weisman application is not prior to the effective filing date of any of the claims currently remaining in the application. The above noted clarification and amendments regarding priority should make these rejections moot. The Weisman patent is not prior to any of the remaining claims in this application and the rejections based upon this reference are believed to be obviated.

CLAIM 7

Claim 7 has been further amended and remains in independent form. The examiner has rejected the subject matter of claim 7 in view of the combined teachings of

the Baca patent as modified by the Powell patent as further modified by the Matsumoto patent and finally in view of the Jorma patent.

The applicants repeat the objections to this fanciful combination set forth in the September 2004 amendment, in which the applicant's noted that in building the examiners suggested combination of references the examiner has effectively destroyed the operation and objects of the individual patents. This combination cannot be said to be obvious to one of ordinary skill in the art. When these references are considered as a whole the clearly teach away from the claimed combination of the present claimed invention. The bits and pieces of the applicants claimed invention can always be found individually in the prior art. It is the combination of these items that is not fairly taught or suggested by the prior art when considered as a whole.

In addition to the above, claim 7 has been amended to clarify that each game piece includes a rotating counting wheel integral with the game piece, wherein the wheel includes indicia that modifies at least one of the character attributes that is associated with at least one visible indicia on the game piece. Even if the prior art were combined in the manner suggested by the examiner there is no teaching or suggestion of this relationship between the indicia on the "wheel" and the character attribute (e.g. range and movement) that is on the game piece. Further, claim 7 defines that at least one visible indicia on the game piece is indicative of a character attribute that is not modified by the wheel indicia (such as character alignment or character name, or attack value or defense value in the disclosed example). This limitation highlights that some of the indicia are associated with the wheel whereas others are not. This arrangement is hard to bootstrap from the applied prior art even if combined as suggested by the examiner. Thirdly, the claim 7 defines the step of manually rotating the rotating counting wheel during the play of the game. In the applied prior art the "wheel" is moved by magnets, whereas in the present claimed invention the counter wheel is manually rotated, generally by rolling along the ground by the user. These additional distinctions cannot be found in the prior art even when combined as suggested by the examiner.

CLAIM 8

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Claim 8 depends from claim 7 and is allowable for all the reasons discussed above in connection with claim 7. Claim 8 further defines the wheel defining that the wheel has a substantially horizontal axis of rotation. Even if the prior art were combined in the manner suggested by the examiner this combination of references would teach away from this orientation. The prior art disc must have the vertical axis of rotation due to the moving magnets.

CLAIM 33

Claim 33 has been further amended and remains in independent form. The examiner has rejected the subject matter of claim 33 in view of the combined teachings of the Baca patent as modified by the Powell patent as further modified by the Matsumoto patent. As noted earlier there is no teaching or suggestion in these references, taken alone or in any reasonable combination thereof, of having at least one character indicia includes a first indicia portion that identifies the attribute and a second numerical indicia portion indicative of the value of the identified attribute. Further, the specific teachings of these patents teach away from the suggested combination as discussed above in connection with claim.

Claim 33 has been amended to further clarify (1) at least one character indicia is associated with the rotating element indicia whereby the rotating element indicia modifies a character attribute indicated by the associated character indicia, and (2) at least one character indicia is not associated with the rotating element indicia. These distinctions were discussed in connection with claim 7 above and are not found in the prior art even if combined in the manner suggested by the examiner.

CLAIM 35

Claim 35 depends from claim 33 and is allowable for the reasons discussed above in connection with claim 33. Claim 35 further defines that the character indicia, as opposed to the rotating element indicia, is selected from the group consisting of text, letters, numbers and combinations thereof and further that at least one of the character indicia is not associated with the rotating element indicia. These features are not found in the Matsumoto patent, taken alone or in combination with the remaining cited references. Claim 35 has been further amended to define that the wheel has a substantially horizontal

axis of rotation. As noted above, this is not found in the prior art, even if combined in the manner suggested by the examiner.

CLAIM 36

Claim 36 depends from claim 35 and is allowable for the reasons discussed above in connection with claim 35. Claim 36 further limits the invention to utilizing randomizing elements for combat dispute resolution. Claim 36 has been amended herein to further define that the wheel is manually rotated. As noted above, in the applied prior art, external magnets are used for dial rotation (generally randomly according to the purpose of the patent).

CLAIMS 137-139

Independent claim 137 is directed to a method of playing a miniature war game on a playing surface with a plurality of game pieces as discussed in the September 2004 response. In an effort to find the earlier claimed elements the Examiner relies upon the teachings of the Baca patent taken in view of the Powell patent taken in view of the Motsumoto Patent taken in view of the Jorma patent and finally taken in view of the Rhea patent. The Baca/Powell/Matsumoto/Jorma/Rhea combination is inappropriate as discussed in the September response.

Claim 137 has been amended herein to further define that each game-piece further includes a rotating element selected from the group consisting of a wheel and a sphere, wherein the rotating element has multiple rotating element indicia thereon, and wherein at least one character indicia is associated with the rotating element indicia whereby the rotating element indicia modifies a character attribute indicated by the associated character indicia. Even if the prior art were combined in the manner suggested by the examiner there is no teaching or suggestion of the claimed relationship between the wheel indicia and the character indicia of the game piece.

Claims 138 and 139 depend, directly or indirectly from claim 137 and are allowable for the reasons discussed above. Further claim 139 defines that the independent indicia includes a first indicia portion that identifies the attribute and a second indicia portion indicative of the value of the identified attribute. This is not found in the prior art as discussed above. Claims 138 and 139 have been amended to define the

manual rotation and the horizontal axis of rotation of the wheel, respectively, of the present invention. As noted above, these distinctions further define the present invention over the applied prior art.

CLAIMS 159 and 161

Claim 159 depends from claim 33 and is allowable for the reasons discussed above in connection with claim 33. Claim 159 further defines the steps of (1) providing a plurality of structural units for forming a variety of simulated structures, and (2) building and placing selected simulated structures on the playing surface. The applied prior art does not fairly teach or suggest the plurality of structural units for forming a variety of simulated structures, and building the same in combination with the remaining claim elements. Claim 161 depends from claim 159 and is allowable for the reasons discussed above in connection with claim 159.

CLAIM 180

Claim 180 defines a method of playing a competitive fantasy game including providing a plurality of game-pieces with each game-piece representative of a game character, wherein each game-piece includes i) a miniature figurine, wherein at least some of the game pieces includes figurines selected from the group consisting of humans, humanoids, monsters, and siege weapons, ii) multiple character indicia thereon, wherein the character indicia is indicative of character attributes of the character including at least the name of the character, and iii) a rotating element having multiple rotating element indicia thereon, at least one rotating element indicia associated with movement of the game piece, and wherein at least one character indicia is associated with at least one of the rotating element indicia. This combination of elements is not found in any reasonable interpretation of the prior art. Miniature figurines are certainly known as are character indicia on game pieces and rotating elements for variable information of a game piece. However, the defined combination of these elements together with the relationship between the character indicia and the rotating element indicia is not found in the prior art of record.

In an effort to find the earlier claimed elements the Examiner relies upon the teachings of the Baca patent taken in view of the Powell patent taken in view of the Motsumoto Patent. It is not clear how this reads on the above identified combinations of

elements, however, claim 180 further defines that at least one character indicia is associated with at least one of the rotating element indicia whereby the rotating element indicia modifies a character attribute indicated by the associated character indicia. Even if the prior art were combined in the manner suggested by the examiner there is no teaching or suggestion of the claimed relationship between the wheel indicia and the character indicia of the game piece.

Claims 184-186

Claims 184-186 depend from claim 180 and define, respectively, that the wheel has a substantially horizontal axis of rotation, the wheel indicia modifies at least one of movement and range values for the character, and the rotating of the rotating element is manually actuated. These limitations further define the present invention as discussed above in connection with similar claim limitations in other pending claims

It is respectfully submitted that the application is in condition for allowance. A favorable action is respectfully requested.

Respectfully Submitted;

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